

Certificate of E-Filing
I hereby certify that this document is being
transmitted to the Patent and Trademark Office
via EFS-Web on April 11, 2009.

/Joseph G. Swan/
Joseph G. Swan

PATENT
Atty. Docket No. 30788-16

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JOHN T. HURST, ET AL.

Serial No.: 09/784,843

Filed: February 15, 2001

For: PROGRAMMING CONTENT
DISTRIBUTION

GROUP ART UNIT: 2142

EXAMINER: DOUGLAS B. BLAIR

CONF. NO.: 3829

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

This submission responds to the Notification of Non-Compliant Appeal Brief mailed on March 27, 2009. In that Notification, it is asserted that the Appeal Brief filed on February 25, 2009 is defective for failure to comply with one or more provisions of 37 CFR § 41.37. Specifically, the Notification states,

Item 4. The “Summary of claimed subject mater” fails to argue independent claims 11, 29 and 33 separately, which shall refer to the specification by page and line number and to the drawings, if any.

In response to this assertion, it is noted that the relevant portion of 37 CFR § 41.37 only states that the Summary section must include:

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.

In particular, there is absolutely no requirement in 37 CFR § 41.37 that each independent claim must be argued or summarized “separately”. Rather, the requirement is simply that the subject matter for each of the independent claims must be explained concisely, with references to the specification.

In the filed Appeal Brief, the last paragraph on page 3, continuing on to the beginning of page 4 (beginning with “Independent claims 11, 29 and 33...”), clearly explains the subject matter of each of independent claims 11, 29 and 33, including appropriate references to the specification.

Appellants note that those independent claims recite similar limitations in different statutory classes. Accordingly, the same summary and specification references apply to each.

In such a case, summarizing all three independent claims together is not only appropriate, but the best approach to satisfy 37 CFR § 41.37. Providing a separate, but substantively identical, summary for each of independent claims 11, 29 and 33 simply would have been redundant. Rather than adding anything of value to the Appeal Brief, Appellants believe that such an approach likely would have violated the requirement of 37 CFR § 41.37 that the explanation of the subject matter be “concise”.

At the same time, such an approach would have created an additional burden for the Board of Patent Appeals and Interferences. It would have required the Board not only to read all three paragraphs (instead of just one), but also to then spend additional time to determine that all three paragraphs are in fact substantively identical to each other.

Finally, contrary to the assertion in the present Notification, independent claims 11, 29 and 33 were not argued separately in the present Appeal Brief. They are argued together - in the section that begins on page 16 of the Appeal Brief.

For all of the foregoing reasons, Appellants respectfully request withdrawal of the assertion that the filed Appeal Brief is non-compliant.

If there are any fees due in connection with the filing of the currently submitted papers that have not been accounted for in this paper or the accompanying papers, please charge the fees to our Deposit Account No. 502490. If an extension of time under 37 C.F.R. 1.136 is required for the filing of the currently submitted papers and is not accounted for in this paper or the accompanying papers, such an extension is requested and the fee (or any underpayment thereof) should also be charged to our Deposit Account.

Dated: April 11, 2009

Respectfully submitted,
JOSEPH G. SWAN, P.C.

JOSEPH G. SWAN,
A PROFESSIONAL CORPORATION
1334 Parkview Avenue , Suite 100
Manhattan Beach, California 90266
Telephone: (310) 372-8624
Facsimile: (310) 356-3845

By /Joseph G. Swan/
Joseph G. Swan
Registration No. 41,338